

Applicant: Joseph R. Berger  
Serial No.: 10/052,961  
Filed: January 18, 2002  
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Supplemental Information Disclosure Statement

In accordance with the duty of disclosure under 37 C.F.R. §1.56, the applicant directs the Examiner's attention to the following items which are listed on the substitute PTO-1449 form attached hereto as **Exhibit A**. Items 1-3 are U.S. Patents and no copies of these references are attached hereto as permitted under 37 C.F.R. §1.98(a)(2)(ii). Copies of items 4-27 are attached hereto as **Exhibits 1-24**.

1. U.S. Patent No. 4,456,596, issued June 26, 1984;
2. U.S. Patent No. 5,434,146, issued July 18, 1995;
3. U.S. Patent No. 5,096,916, issued March 17, 1992;
4. STN Registry Search Results for Synonymous Chemical Names of Oxandrolone, entry date November 16, 1984; (**Exhibit 1**)
5. Verified Complaint For Patent Infringement, United States District Court For The District of New Jersey, Savient Pharmaceuticals, Inc. v. Sandoz, Inc and Upshur-Smith Laboratories, Inc, filed with clerk December 4, 2006; (**Exhibit 2**)
6. Notice of Appeal, United States District Court For The District of New Jersey, Savient Pharmaceuticals, Inc. v. Sandoz, Inc and Upshur-Smith Laboratories, Inc, dated December 12, 2006; (**Exhibit 3**)
7. Sandoz's Memorandum In Opposition To Savient's Emergency Motion For Stay Pending Appeal Of The District Court's Order Vacating Temporary Restraints And Denial Of A Preliminary Injunction, United States District Court For The District of New Jersey, Savient Pharmaceuticals, Inc. v. Sandoz, Inc and Upshur-Smith Laboratories, Inc, dated December 12, 2006; (**Exhibit 4**)
8. Upshur-Smith's Response In Opposition To Savient's

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Emergency Motion For Stay Pending Appeal Of The District Court's Order Vacating Temporary Restraints And Denial Of A Preliminary Injunction, United States District Court For The District of New Jersey, Savient Pharmaceuticals, Inc. v. Sandoz, Inc and Upshur-Smith Laboratories, Inc, dated December 12, 2006; (**Exhibit 5**)

9. Savient's Reply In Support Of Its Emergency Motion For Stay Pending Appeal Of The District Court's Order Vacating Temporary Restraints And Denial Of A Preliminary Injunction, United States District Court For The District of New Jersey, Savient Pharmaceuticals, Inc. v. Sandoz, Inc and Upshur-Smith Laboratories, Inc, dated December 14, 2006; (**Exhibit 6**)
10. Office Action issued March 23, 2007 in connection with U.S. Serial No. 10/799,197; (**Exhibit 7**)
11. Office Action issued June 30, 2006 in connection with U.S. Serial No. 10/799,197; (**Exhibit 8**)
12. Final Office Action issued February 28, 2006 in connection with U.S. Serial No. 10/799,197; (**Exhibit 9**)
13. Office Action issued June 1, 2005 in connection with U.S. Serial No. 10/799,197; (**Exhibit 10**)
14. Office Action issued March 23, 2007 in connection with U.S. Serial No. 10/799,264; (**Exhibit 11**)
15. Office Action issued June 30, 2006 in connection with U.S. Serial No. 10/799,264; (**Exhibit 12**)
16. Final Office Action issued March 13, 2006 in connection with U.S. Serial No. 10/799,264; (**Exhibit 13**)
17. Office Action issued June 8, 2005 in connection with U.S. Serial No. 10/799,264; (**Exhibit 14**)
18. Office Action issued June 22, 1995 in connection with U.S. Serial No. 08/244,988; (**Exhibit 15**)
19. Office Action issued March 2, 2000 in connection with U.S. Serial No. 08/244,988; (**Exhibit 16**)

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20. Office Action issued May 17, 2001 in connection with U.S. Serial No. 09/469,817; (**Exhibit 17**)
21. Notice of Allowability issued October 18, 2004 in connection with U.S. Serial No. 10.011,377; (**Exhibit 18**)
22. Office Action issued July 28, 2004 in connection with U.S. Serial No. 10/011,377; (**Exhibit 19**)
23. Notice of Allowability issued June 10, 2004 in connection with U.S. Serial No. 10/011,377; (**Exhibit 20**)
24. Office Action issued December 17, 2003 in connection with U.S. Serial No. 10/011,377; (**Exhibit 21**)
25. Office Action issued June 18, 2003 in connection with U.S. Serial No. 10/011,377; (**Exhibit 22**)
26. Office Action issued December 1, 1999 in connection with U.S. Serial No. 08/985,734; (**Exhibit 23**) and
27. Office Action issued July 7, 1998 in connection with U.S. Serial No. 08/985,734; (**Exhibit 24**).

This Supplemental Information Disclosure Statement is being submitted under 37 C.F.R. §1.97(b)(4), before the mailing of a first Office Action on the merits after the filing of an RCE.

The Examiner is respectfully requested to make these references of record in the present application by initialing and returning a copy of the enclosed Form PTO 1449 substitute.

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No fee, except the enclosed total fee of \$620.00, including a \$395.00 fee for filing the accompanying RCE and a \$225.00 fee for a two month extension of time, is deemed necessary in connection with the filing of this Amendment and Supplemental Information Disclosure Statement. However, if any additional fees are deemed necessary, authorization is hereby given to charge the amount of such fees to Deposit Account No. 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	
<i>Gary J. Gershik</i> Gary J. Gershik Reg. No. 39,992	<i>8/23/07</i> Date

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Form PTO-1449  
Substitute

U.S. Department of Commerce  
Patent and Trademark Office

Application Number	10/052,961
Filing Date	January 18, 2002
First Named Inventor	Joseph R. Berger
Art Unit	1617
Examiner Name	S. Wang
Attorney Docket No.	44657-AAA-PCT-US JPW/GJG/BJA/PJS

# INFORMATION DISCLOSURE STATEMENT

(Use several sheets if necessary)

## U.S. PATENT DOCUMENTS

Examiner Initials <sup>2</sup>	Cite No. <sup>1</sup>	Document Number Number-Kind Code <sup>3</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document
		4,456,596	6-26-1984	Schafer, Rolf.
		5,434,146	7-18-1995	Labrie et al.
		5,096,916	3-17-1992	Skupkin

## FOREIGN PATENT DOCUMENTS

Examiner Initials <sup>2</sup>	Cite No. <sup>1</sup>	Foreign Patent Document Country Code <sup>3</sup> Number <sup>4</sup> Kind Code <sup>5</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	T <sup>6</sup>

EXAMINER  
SIGNATURE

DATE CONSIDERED

\*EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609: Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds of Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup> Applicant is to place a check mark here if English Language Translation is attached.

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Serial No.: 10/052,961  
Filed: January 18, 2002  
Exhibit A

<b>Form PTO-1449</b> <b>Substitute</b>  <b>U.S. Department of Commerce</b> <b>Patent and Trademark Office</b>  <b>INFORMATION DISCLOSURE CITATION</b> (Use several sheets if necessary)	<b>Application Number</b>	10/052,961
	<b>Filing Date</b>	January 18, 2002
	<b>First Named Inventor</b>	Joseph R. Berger
	<b>Art Unit</b>	1617
	<b>Examiner Name</b>	S. Wang
	<b>Attorney Docket No.</b>	44657-AAA-PCT-US /JPW/GJG/BJA/PJS

### NON PATENT LITERATURE DOCUMENTS

Examiner Initials	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
		STN Registry Search Results for Synonymous Chemical Names of Oxandrolone, entry date November 16, 1984.	
		December 4, 2006, Verified Complaint For Patent Infringement, Savient Pharmaceuticals, Inc. v. Sandoz, Inc. and Upshur-Smith Laboratories, Inc., Case No. 06-CV-5782 (PGS), United States District Court For The District of New Jersey	
		December 12, 2006, Notice of Appeal, Savient Pharmaceuticals, Inc. v. Sandoz, Inc. and Upshur-Smith Laboratories, Inc., Case No. 06-CV-5782 (PGS), United States District Court For The District of New Jersey	
		December 12, 2006, Sandoz's Memorandum In Opposition To Savient's Emergency Motion For Stay Pending Appeal Of The District Court's Order Vacating Temporary Restraints And Denial Of A Preliminary Injunction, Savient Pharmaceuticals, Inc. v. Sandoz, Inc. and Upshur-Smith Laboratories, Inc., Case No. 06-CV-5782 (PGS), United States District Court For The District of New Jersey	
		December 12, 2006, Upshur-Smith's Response In Opposition To Savient's Emergency Motion For Stay Pending Appeal Of The District Court's Order Vacating Temporary Restraints And Denial Of A Preliminary Injunction, Savient Pharmaceuticals, Inc. v. Sandoz, Inc. and Upshur-Smith Laboratories, Inc., Case No. 06-CV-5782 (PGS), United States District Court For The District of New Jersey	
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		Final Office Action issued February 28, 2006 in connection with U.S. Serial No. 10/799,197	

<b>EXAMINER SIGNATURE</b>	<b>DATE CONSIDERED</b>
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\*EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609: Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup>Applicant's unique citation designation number (optional). <sup>2</sup>Applicant is to place a checkmark here if English language Translation is attached.

<b>Form PTO-1449</b> Substitute		<b>U.S. Department of Commerce</b> <b>Patent and Trademark Office</b>		<b>Application Number</b> 10/052,961	<b>Filing Date</b> January 18, 2002
<b>INFORMATION DISCLOSURE CITATION</b> (Use several sheets if necessary)				<b>First Named Inventor</b> Joseph R. Berger	
				<b>Art Unit</b> 1617	
				<b>Examiner Name</b> S. Wang	
				<b>Attorney Docket No.</b> 44657-AAA-PCT-US /JPW/GJG/BJA/PJS	
<b>NON PATENT LITERATURE DOCUMENTS</b>					
<b>Examiner Initials</b>	<b>Cite No.<sup>1</sup></b>	<b>Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.</b>			<b>T<sup>2</sup></b>
		Office Action issued June 1, 2005 in connection with U.S. Serial No. 10/799,197			
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		Office Action issued June 8, 2005 in connection with U.S. Serial No. 10/799,264			
		Office Action issued January 23, 1996 in connection with U.S. Serial No. 08/244,988			
		Office Action issued March 2, 2000 in connection with U.S. Serial No. 08/244,988			
		Office Action issued May 15, 2001 in connection with U.S. Serial No. 09/469,817			
		Notice of Allowability issued October 18, 2004 in connection with U.S. Serial No. 10/011,377			
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